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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/688,097

10/17/2003

Glenn C. Godoy

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EXAMINER

PONIKIEWSKI, TOMASZ

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,097

Applicant(s)

GODOY ET AL.

Examiner

Tomasz Ponikiewski

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/17/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-20 are pending.

Claim Objections

1. Claims 15, 17, 17, 19, and 20 recite the word "for" in the body of the claims. It indicates intended use and as such does not carry patentable weight. The word could be changed to recite "to". The limitations following the phrase "for" describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase "for" do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

Claims 1, 10, 13-14, and 17-18 are objected to because of the following informalities: the recitation of "if" makes the statement(s) following the recitation totally optional. As such the action does not have to occur. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 1 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 does not list any hardware (i.e. computer) tied to the steps in order to operate the steps of the claims therefore resulting in software only implementation.
Who does the displaying?

Claim 18 does not list any computer/processor that executes the program code and as such is considered software only.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "set of keys". It is unclear to the examiner what applicant means by the term "key", what and when are they set. Appropriate clarification is required.

Claim 12 recites the limitation "obtaining custom data". It is unclear to the examiner where this data comes from, who or what supplies it. Appropriate clarification is required.

Claim 14 recite the word "for" in the preamble. There is no nexus between preamble and the body of claim because "for" is intended use never having to be realized and body of the claim doesn't recite the intended use of "management custom data during electronic purchase"

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 9, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishimura (US 2001/0051904 A1).

As per claim 1 Nishimura is directed to a method of managing custom data during an electronic purchase, the method comprising:

selecting an item for purchase (page 5, paragraph 0073) ;

determining a set of attributes for the item (page 4, paragraph 0062);

comparing the set of attributes to a set of keys (page 5, paragraph 0078, lines 11-15, wherein the "keys" could mean the choices available for customization);
and displaying a custom data form if the set of attributes matches the set of keys (page 7, paragraph 0103, lines 7-9).

As per claim 2 Nishimura is directed to the selecting step comprises:
adding the item to an electronic shopping cart (page 7, paragraph 0101, wherein item is added to cart after the selects the item);
selecting to checkout the electronic shopping cart (page 7, paragraph 0102, lines 7-10, wherein the client determines whether the item appears to be the one selected);
and obtaining purchase information for the electronic purchase (page 7, paragraph 0103, lines 5-6).

As per claim 3 Nishimura is directed to wherein the custom data form is displayed after the obtaining step (page 7, paragraph 0103, lines 7-9).

As per claim 4 Nishimura is directed to comprising generating the custom data form for the item (page 7, paragraph 0103, lines 7-9).

As per claim 5 Nishimura is directed to comprising obtaining custom data using the custom data form (page 7, paragraph 0103, lines 7-9).

As per claim 6 Nishimura is directed to comprising storing the obtained custom data in a database (page 4, paragraph 0063, lines 8-12, wherein custom data can mean any information about the product).

As per claim 9, Nishimura is directed to the custom data form is displayed once for a plurality of items that match the set of keys (figure 9, wherein the form is displayed matching the selected data).

As per claim 14 Nishimura is directed to a system for managing custom data during an electronic purchase, the system comprising:

a selection system for allowing a user to select an item for purchase (page 5, paragraph 0073);

an attribute system for determining a set of attributes for the item (page 4, paragraph 0062);

a key system for comparing the set of attributes to a set of keys (page 5, paragraph 0078, lines 11-15, wherein the “keys” could mean the choices available for customization);

and a form system for displaying a custom data form if the set of attributes matches the set of keys (page 7, paragraph 0103, lines 7-9).

As per claim 15 Nishimura is directed to comprising a checkout system for obtaining purchase information for the item (page 7, paragraph 0103, lines 5-6).

As per claim 16 Nishimura is directed to comprising a storage system for storing custom data, wherein the form system further obtains the custom data using the custom data form (page 4, paragraph 0063, lines 8-12, wherein custom data can mean any information about the product).

As per claim 18 Nishimura is directed to a computer program product stored on a recordable medium for managing custom data during an electronic purchase, which when executed comprises:

program code for allowing a user to select an item for purchase (page 5, paragraph 0073);

program code for determining a set of attributes for the item (page 4, paragraph 0062);

program code for comparing the set of attributes to a set of keys (page 5, paragraph 0078, lines 11-15, wherein the "keys" could mean the choices available for customization);

and program code for displaying a custom data form if the set of attributes matches the set of keys (page 7, paragraph 0103, lines 7-9).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2165

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 2001/0051904 A1) in view of Leber et al. (US 2003/0182391 A1).

As per claim 7 Nishimura does not teach concatenating custom data obtained using at least two input fields in the custom data form.

Leber et al. does teach concatenating custom data obtained using at least two input fields in the custom data form (Leber et al., figure. 2b, 288).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura by teachings of Leber et al. to include concatenating custom data obtained using at least two input fields in the custom data form because doing so keeps all the relevant data together.

Nishimura as modified still does not teach storing the concatenated custom data as a large object in the database.

Leber et al. does teach storing the concatenated custom data as a large object in the database (Leber et al., page 4, paragraph 0067, lines 7-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Leber et al. to include saving the information in a database because it is more efficient to store the data in a repository that is easily accessed.

As per claim 8 Nishimura as modified still does not teach comprising parsing the concatenated custom data to determine the custom data obtained for one of the at least two fields.

Leber et al. does teach comprising parsing the concatenated custom data to determine the custom data obtained for one of the at least two fields (Leber et al. page 4, paragraph 0067, lines 2-4, wherein "concatenated custom data" could mean "message"; figure. 2b, 288).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Leber et al. to include parsing the concatenated custom data because the data would only make sense it placed in proper format.

9. Claims 10, 12-13, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 2001/0051904 A1) in view of Christensen et al. (US 2002/0154114 A1).

As per claim 10 Nishimura is directed to a method of managing custom data during an electronic purchase, the method comprising:

selecting an item for purchase (page 5, paragraph 0073);

obtaining purchase information for the item (page 7, paragraph 0103, lines 5-6);

determining a set of attributes for the item (page 4, paragraph 0062);

comparing the set of attributes to a set of keys (page 5, paragraph 0078, lines 11-15, wherein the “keys” could mean the choices available for customization);

displaying a custom data form if the set of attributes matches the set of keys (page 7, paragraph 0103, lines 7-9);

Nishimura does not teach obtaining custom data using at least one input field in the custom data form.

Christensen et al. does teach obtaining custom data using at least one input field in the custom data form (Christensen et al., page 8, paragraph 0049, lines 21-25, wherein “input fields” could mean “selectable options”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura by teachings of Christensen et al. to include input fields in custom form because having more choices mean more variety to satisfy the selection.

Nishimura as modified still does not teach storing the obtained custom data and purchase information in a database.

Christensen et al. does teach and storing the obtained custom data and purchase information in a database (Christensen et al., page 8, paragraph 0049, lines 48-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Christensen et al. to include saving the information in a database because it is more efficient to store the information about item and purchase data together for good recordkeeping.

As per claim 12 Nishimura as modified is directed to the storing step further comprises storing an entry in a custom data group table for a custom data group, wherein the custom data group includes each item in the electronic purchase that matches the set of keys (Nishimura, figure 2 shows table with various keys).

As per claim 13 Nishimura as modified is directed to storing the large object in an entry in a group custom data table if the custom data form is displayed once for the custom data group (Christensen et al., page 5, paragraph 0049, lines 48-51, wherein the database is made up of tables);

and storing the large object in an entry in an item custom data table if the custom data form is displayed for each item in the custom data group (Christensen et al., page 5, paragraph 0049, lines 48-51, wherein the database is made up of tables).

As per claim 17 Nishimura is directed to the storage system includes:

a custom data group table for storing an entry for a custom data group, wherein the custom data group includes each item in the electronic purchase that matches the set of keys (Nishimura, figure 2 shows table with various keys);

Nishimura does not teach group custom data table for storing an entry for the custom data for the custom data group if the custom data form is displayed once for the custom data group.

Christensen et al. does teach group custom data table for storing an entry for the custom data for the custom data group if the custom data form is displayed once for the custom data group (Christensen et al., page 5, paragraph 0049, lines 48-51, wherein the database is made up of tables).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura by teachings of Christensen et al. to include group custom data table for storing an entry for the custom data for the custom data group if the custom data form is displayed once for the custom data group because storing data in tables is convenient and efficient process.

Nishimura as modified still does not teach an item custom data table for storing an entry for the custom data for each item in the custom data group if the custom data form is displayed once for each item in the custom data group.

Christensen et al. does teach an item custom data table for storing an entry for the custom data for each item in the custom data group if the custom data form is displayed once for each item in the custom data group (Christensen et al., page 5, paragraph 0049, lines 48-51, wherein the database is made up of tables).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Christensen et al. to include an item custom data table for storing an entry for the custom data for each item in the custom data group if the custom data form is displayed once for each item in the custom data group because storing data in tables is convenient and efficient process.

As per claim 19 Nishimura is directed to further comprising:

program code for obtaining purchase information for the item (page 7, paragraph 0103, lines 5-6);

program code for obtaining custom data using the custom data form (page 7, paragraph 0103, lines 7-9);

Nishimura does not teach program code for storing the custom data and the purchase information.

Christensen et al. teaches program code for storing the custom data and the purchase information (Christensen et al., page 5, paragraph 0049, lines 48-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura by teachings of Christensen et al. to include saving the information in a database because it is more efficient to store the information about item and purchase data together for good recordkeeping.

As per claim 20 Nishimura as modified is directed to comprising program code for processing the custom data (Nishimura, figure 4, s20, wherein processing happens when the purchase is submitted).

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 2001/0051904 A1) and Christensen et al. (US 2002/0154114 A1) above, and further in view of Leber et al. (US 2003/0182391 A1).

As per claim 11 Nishimura and Christensen et al. do not teach concatenating custom data obtained for a plurality of input fields.

Leber et al. teaches concatenating custom data obtained for a plurality of input fields (Leber et al., figure. 2b, 288).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Leber et al. to include concatenating of data because doing so keeps all the relevant data together.

Nishimura and Christensen et al. as modified still do not teach storing the concatenated custom data as a large object in the database.

Leber et al. teaches storing the concatenated custom data as a large object in the database (Leber et al., page 4, paragraph 0067, lines 7-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Leber et al. to include saving the information in a database because it is more efficient to store the data in a repository that is easily accessed.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shah et al. (US 2004/0204998 A1) teaches concatenation.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tomasz Ponikiewski
June 8, 2006


FRANTZ COBY
PRIMARY EXAMINER